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IN THE

Supreme Court of the United States

OCTOBER TERM, [redacted] 1969

No. 251

MAGNETIC HEATING CORPORATION,
THERMATOOL CORPORATION,
DANIEL G. OSTERER,
HERMAN C. MORRIS,
AMERICAN MACHINE & FOUNDRY COMPANY,

Petitioners,

—v.—

JULIUS E. FOSTER,

Respondent.

RESPONDENT'S REPLY IN OPPOSITION TO THE PETITION FOR A WRIT OF CERTIORARI

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There Is No Such "Question Presented" in This Case As Petitioners Have Raised

Underlying petitioner's so-called "Question Presented" (pp. 2 and 3 of the petition), are at least three purported factual situations, none of which exists in this case, as petitioners should well know; and each of which has been specifically found *not* to exist in this case by the District Court.

At best, thus, the so-called "Question Presented" is an attempt to have this Court overturn findings of fact under

the guise of a question of law; but in reality, this is an unbelievably specious petition; this is precisely the approach that petitioners attempted in the Circuit Court of Appeals and failed (p. 8 Brief of Appellee).

Specifically, the so-called "Question Presented" requires:

(1) a *"deliberate delay"* by respondent in the issuance of the patent;

(2) intervening rights of petitioners during that time, who supposedly had *"independently developed their allegedly infringing system"*; and

(3) a finding of infringement supposedly based solely on the doctrine of "equivalents", that purportedly expands the scope of the patent in violation of legal principles established by this Court.

There is, however, not a word of truth in any of these supposed statements of fact underlying "the Question".

As for *"deliberate delay"*, the District Court found *as a fact*

> "that there was *nothing deliberate* . . . insofar as delaying the benefit of the invention to the public may be concerned"; and

that the delay was for good "reason" and "in good faith" (petition, p. 11A; emphasis supplied).

Turning to petitioner's fancied intervening rights, the District Court found *as a fact* that

> "there is no evidence of any intervening invention by defendants or by others of such a combination before this Foster filing date" (petition, p. 13a); and

that even if the "earliest and *uncorroborated* date of disclosure by any of the defendants" were to be accorded consideration, this was "several months *after* the filing

date of the new application of Foster that matured into the patent in suit" (emphasis supplied).

And, lastly, as to the pretense of improper extension of the doctrine of equivalents, the District Court after considering the "file wrapper of the Foster patent" (petition, pp. 9a, 10a), quoting from it in detail and discussing how the claims were allowed over the prior art (including the very Sessions patent belabored by petitioners on pages 6, 13-17 of the petition), made specific findings of *direct* infringement, not requiring invocation of any doctrine of equivalents; to wit:

> "Foster interchangeably used both the term "electromagnetic" and just "magnet" throughout the patent";
>
> "magnetic control of currents is *identically* affected by magnetic flux whether such flux is produced by a directly excited electromagnet or by an induced *magnet core*"; (petition, p. 6a).

and, that

> "the defendants' structures operate in substantially the *same* manner with substantially the *same* elements to attain the *same* results described and claimed in the Foster patent in suit" (petition, pp. 8a, 9a). (Emphasis supplied.)

More than this, without raising up any "equivalents" at all, and without relying on any doctrine of equivalency, the District Court went on to explain that infringement lies even in the *narrowest* possible interpretation of the Foster claims:

> "Even if *narrowly construed*, however, *each* and *every step* and *element* of Foster claims 5, 16, 19 and 22 *finds response* in *terms*, *function* and *result* in the defend-

ants' Thermatool apparatus" (petition, p. 15a, emphasis supplied).

Thus, the so-called "Question Presented" explodes into thin air; and there is no question at all before this Court, let alone the kind of substantial federal question that warrants certiorari.

Altogether apart from the above, petitioners "Question" is a newly concocted issue in this Court, since absolutely no error was ascribed by defendants in the Court of Appeals to the District Court's findings of lack of deliberate delay and intervening rights involved in the "Question". Even had this been a bona fide "Question", therefore, in the words of this Court, it presents "no cause for deviating from . . . normal policy of not considering issues which have not been presented to the Court of Appeals . . ." *Neely* v. *Eby Construction Co., Inc.*, 386 U.S. 317, 330 (1966).

Petitioner's Statement of Case and Argument

We believe that we have shown enough above to make unnecessary a detailed exposition of all of the half-truths and positive mis-statements occurring throughout the petition; though we are compelled to show the patent falsity of certain major statements. May we thus respectfully issue a *caveat*, inviting this Court's attention to the District Court's comments on the degree of reliability of petitioners' evidence (petition, pp. 7a, 8a),—"inconsistent in important particulars and lacked persuasiveness"—; their tactics in submitting invention record exhibits, represented to the District Court as "chronological", including undated and admittedly out-of-place records, attempting to anticipate the patentee (Appendix p. 131a); and their conduct in the Court of Appeals in omitting from a re-

produced exhibit, without explanation, the most telling document (Brief of Appellee, pp. 8-9).

Turning to the major mis-statements, we have shown that the District Court did *not* just rely on the doctrine of equivalents in finding infringement; that far from expanding the scope of the Foster claims, that Court specifically found infringement even if the Foster claims were *"narrowly construed"* (petition, p. 15a); that in so doing, the District Court construed the claims in the light of a careful study of the file history of the patent and the prior art (petition, pp. 9a, 10a); that the District Court found that petitioners were *not* just practicing the process of the expired Sessions patent, as they would have this Court believe, but that petitioners use "the Foster concept" and attain Foster's new results (petition p. 10a). (Emphasis supplied.)

The inappositeness of petitioners' citations should thus be evident. The District Court (and the Court of Appeals) did in fact follow what petitioners concede to be the precise proper procedure (petition, p. 11). They, in petitioners' own words, "strictly construed" the patent and limited "Foster's monopoly to the invention described and claimed in it, *Thompson* v. *Wastinghouse Electric & Mfg. Co.*, 116 F. 2d 422, 435 (2 Cir. 1940)."

The District Court, indeed, followed the procedure outlined by this Court in each of the decisions cited on pages 13 to 15 of the petition, and narrowed (not expanded) the Foster claims to what the file history required, and then found that petitioners were not using just the prior art, but were using *"precisely"* what the Foster claims were allowed, over such prior art, to cover (petition, p. 10a). (Emphasis supplied.)

As for the doctrine of *Woodbridge* v. *United States*, 263 U.S. 50 (1923), the excerpt on page 10 of the petition clearly shows that it involves circumstances where an in-

ventor acts "deliberately and without excuse". The District Court found the contrary here, and thus explained in its decision (petition, p. 14a), that the *Woodbridge* case was "distinguishable and inapplicable to the facts hereinabove set forth".

CONCLUSION

The so-called "Question Presented" has no bearing upon this case and is entirely without merit.

There is no conflict with any decisions of this Court or any other courts.

The petition should be denied.

Respectfully submitted,

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